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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,061	09/05/2003	Roy R. Vann	03 PAT 191	8534
27645	7590	05/24/2004	EXAMINER	
ALWORTH LAW & ENGINEERING 505 CUMBERLAND ROAD TYLER, TX 75703-9324			SMITH, MATTHEW J	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

45

Office Action Summary	Application No. 10/656,061	Applicant(s) VANN, ROY R.	
	Examiner Matthew J. Smith	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) 2-4 and 6 is/are objected to.
- 8) ☒ Claim(s) 7-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20030905</u> . | 6) <input type="checkbox"/> Other: ____. |

The Petition to make Special has been granted 27 April 2004. This application is accorded special status entitling the applicant to examination out of turn and an interference search.

An interference search was completed 21 April 2004. No interfering application was discovered

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to spotting chemicals, classified in class 166, subclass 305.1.
- II. Claims 7-10, drawn to clearing sand, classified in class 166, subclass 312.

The inventions are distinct, each from the other because of the following reasons:

Inventions I. and II. are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects since the sand clearing invention does not involve any makeup fluid or chemicals.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with C.W. Alworth on 21 April 2004 a provisional election was made without traverse to prosecute the invention of group I., claims 1-6.

Art Unit: 3672

Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wellhead structure with the claimed valves must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (5020592) in view of Langseth et al. (6357525).

Muller et al. disclose a method for spotting chemicals in production tubing using makeup fluid and a downhole vent-dump valve 32 having a closed position and a venting position in a well having a pump and associated means for driving the pump, a wellhead and control valve 19 comprising: preparing the chemical to be spotted 22; attaching the chemical to be spotted to the wellhead control valve 19; ceasing pumping operations; opening the control valve 19 leading to the chemical; drawing up on the pump drive means (col. 14, line 56) thereby opening the vent-dump valve 32 and placing the vent-dump valve in the venting position, through ports 35, 87 (col. 15, line 9) thereby allowing the chemical to be drawn into the well; closing the control valve 19 leading to chemical as the supply chemical is exhausted; lowering the pump drive means (col. 15, line 26) thereby placing the vent-dump valve in the closed position and, restoring the well to normal operating conditions (col. 15, lines 50-52).

This reference does not disclose preparing the makeup fluid; attaching the makeup fluid to a wellhead valves; opening the control valve leading to the makeup fluid; and as the supply of makeup fluid is exhausted, closing the control valve leading to makeup fluid.

Langseth et al. present makeup or kill fluid after a spotting chemical (col. 6, lines 53-65), valves 42, 44 for the chemical and kill fluid in a well operation.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the structure and method of supplying makeup fluid to the Muller et al. system in order to ensure the annulus remains filled to prevent a blowout (Langseth et al. col. 6, lines 63-65).

Allowable Subject Matter

Claims 2-4, and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hartsell (2562458) shows a dump valve. Watson presents spotting fluid. Williamson, Jr. and Allamon et al. display downhole valves that operate repeatedly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 703-305-5135. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

MJS *MJS*
22 April 2004